

Remarks

Applicants traverse this restriction requirement based in part upon cases such as *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) as well as MPEP 803.02. Since the decisions in *In re Weber* and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which Applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

The present application entered the US national phase through the PCT under 35 U.S.C. 371. The prosecution of an international application that enters the national stage proceeds in the same manner as a domestic application except in restriction practice where the “unity of invention” standard is applied under 37 CFR § 1.475. MPEP 1893.03. Unity of invention was not questioned in the international phase before the PCT preliminary examining authority.

Applicants assert that the Office has failed to appreciate both the single general inventive concept that links the different categories of claims presented and the availability of prosecuting certain claim combinations in the same application. First of all, Applicants submit that the essence of the invention resides in the compounds of formula I, which are prodrug forms of mGluR2 receptor agonist compounds with increased oral bioavailability and wherein variable X is provisionally elected, with traverse, as S or SO₂. Those compounds are present in the different claim types – i.e. the compound, composition, process, and method claims – available in Groups I, III, and IX provided by the Office. These compounds, therefore, provide a single general inventive concept linking the different claim types present in Groups I, III, and IX. Furthermore, there are three particular situations for which the method for determining unity of invention contained in PCT Rule 13.2 is explained in greater detail. One of those situations is for combinations of different categories of claims. The method for determining unity of invention under PCT Rule 13 shall be construed as permitting, in particular, the inclusion of certain combinations of claims of different categories in the same international application. One such permitted combination involves an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the product, and an independent claim for a use of the product. See MPEP 1850 III. A. (A). Applicants submit that the substance of the claims contained in Group I (compounds and compositions of formula I), Group III (process for preparing compounds and compositions of [formula] I), and Group IX (method of using compounds of [formula] I) fall within the noted permitted combination available under PCT Rule 13.

These claims, therefore, should be prosecuted together for the present application. Applicants submit that in order to fully comport with guidance provided under Rule 13, the noted claims can be modified, if necessary, from a dependent to an independent claim format.

Additionally, the Office asserts that the genus of compounds defined by formula I are an improper Markush group. While Applicants in no way acquiesce to the merits of the Office's assertion, Applicants, as noted above, provisionally elect, with traverse, Group I as well as the permissible combination with Groups III and IX. Also, as the Examiner has not issued a Markush group objection, Applicants have no comments on this observation.

Applicants also note the Office's comments regarding Massey et al. (U.S. Patent No. 5,688,826) and cited on Form PTO-892 in view of PCT Rules 13.1 and 13.2. The Office urges that formula II does not define a contribution over the art, citing Massey. Applicants have understood this statement by the Office as merely supporting its proposition that the restriction is proper, not as a rejection over the art. Applicants will, thus, refrain from any further comment pertaining to Massey at this point in the prosecution of the present application.

In light of the above, Applicants assert that the requirement for restriction in the present application is improper and request that the Office rejoin Groups I, III, and IX.

Respectfully submitted,

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